REMARKS/ARGUMENTS

Election/Restrictions

Applicants confirm election of Species B, a modular surgical instrument. Claims 3-7, 9 and 11-21 read on this embodiment. Of claims 11-21, claims 11, 13, 18 and 20 had previously been withdrawn. The claims presently at issue are as follows: 3-7, 9, 12, 14-17 and 19.

Support for Amendments

Support for the amendments to the claims is provided in FIGS. 13, 17 and 18, for example.

Drawings

The objection to the drawings is respectfully traversed. Claim 9 has been amended and claim 21 has been withdrawn, obviating the rejection. Each of the remaining features recited in the objection are shown in the drawings as set forth below:

Claim Feature	Drawing
The kit comprising separate actuator modules and tool modules (claims 12 and 17)	FIG. 16 illustrates the actuator module separate from the tool module. FIG. 17 illustrates the tool module separate from the actuator module. FIG. 18 illustrates these two modules assembled together.
an actuator module and a discrete tool module (claim 5)	FIG. 16 illustrates the actuator module separate from the tool module. FIG. 17 illustrates the tool module separate from the actuator module. FIG. 18 illustrates these two discrete modules assembled together.
the tool module being free from any structure for moving the slide member in the distal direction (claim 16)	FIG. 17 is a cross-section of the tool module. No structure for moving the slide member 82 in the distal direction is illustrated. The spring 104 would serve to move the slide member in the proximal direction.

Claim Objections

Claim 3 has been amended in compliance with paragraphs 12-18 of the Office Action.

Claim 5 has been amended in compliance with paragraph 19 of the Office Action.

The objection to claim 12 in paragraph 20 has been obviated by the amendment.

Claim Rejections – 35 USC §112

The rejection of claims 3 and 16 under 35 USC 112, second paragraph, as being indefinite is respectfully traversed.

Amended claim 3 clarifies that the slide member and elongate portion of the surgical implement are capable of being moved in a linear distal direction by pivoting the lever so that the integral cam of the lever pushes against the drive surface of the slide member. Claim 3 also specifies that the integral cam of the lever is adjacent to the drive surface of the slide member and that the surgical instrument is free of any mechanical connection between the lever and the slide member. The slide member is capable of being moved by the action of the integral cam of the lever, received in the slide member slot adjacent to the drive surface, which essentially pushes the slide member in a distal direction. While contact between the lever and the slide member is necessary for the cam portion of the lever to push the slide member distally, there need not be any mechanical connection between them to effect this movement. It is the undersigned's understanding that cams and followers commonly contact each other to effect movement without being mechanically connected together. Accordingly, claim 3 complies with 35 USC §112, second paragraph.

Amended claim 16 clarifies that the channel of the hollow elongate support member is sized and shaped to allow linear movement of the surgical implement in the proximal and distal direction and that the channel of the housing is sized and shaped to allow linear movement of the slide member in the proximal and distal directions in the channel. There is

no positive recitation of the surgical implement being capable of reciprocal motion. Claim 16 is believed to comply with 35 USC §112, second paragraph.

Claim Rejections – 35 USC §102

The rejection of claims 3-7, 9, 12, 14-17, 19 and 21 under 35 USC §102(a) as being anticipated by Yoon et al (hereinafter "Yoon") is respectfully traversed.

In paragraph 27 of the Office Action, Yoon element 24 is characterized as comprising a "lever" and element 18 is characterized as a "handle". However, as can be seen from a comparison of Yoon FIGS. 15, 21 and 22,Yoon element 24 is not connected to element 18 at a pivotal connection; instead, element 24 appears to be connected to element 14 (Yoon, col. 8, line 67 – col. 9, line 3: "A rearward, proximal or second handle 24 is disposed proximally of first handle 18 and is pivotally connected to middle tubular member 14 via slots 26 on opposite sides of outer tubular member 12.") and elements 24 and 18 are axially movable with respect to each other. The description of the connection of element 24 in Yoon at col. 13, lines 11-34 refers to pin 172 extending through the ears 168 of element 24 and slots 26 in the outer tubular member and holes 56 in the middle tubular member, rather than through any part of handle 18. Accordingly, claim 3 does not read on Yoon.

In addition, if element 174 of Yoon is considered to comprise an integral drive portion, FIG. 1 of Yoon shows this surface as being exposed; no slot is seen to receive this portion of element 24. Again referring to col. 13, lines 11-34, Yoon teaches that the lateral spacing between ears 168 corresponds generally to the other diameter of outer tubular member 12; with this spacing, and with the illustrations in FIGS. 1 and 2, the shapes of the components do not appear to allow the ears 168 to be received within any slot. Considering element 176 of Yoon,

this element is not integral with element 24 (see col. 13, lines 42-50). Accordingly, claim 3 does not read on Yoon.

With respect to independent claim 5, the characterization of the handle as being substantially open above the support surface is respectfully traversed. The Office Action refers to element 118 as the support surface. FIG. 2 and the cross-section of FIG. 9 illustrate a solid material overlying surface 118. Accordingly, Yoon does not disclose a handle that is substantially open above the support surface and claim 5 does not read on Yoon.

In addition, in the Office Action, Yoon element 12 is characterized as the housing. Element 12 is not sized and shaped to fit between the proximal and distal ends of the support portion of the handle 18. Accordingly, claim 5 does not read on Yoon.

If element 12 of Yoon is considered to comprise a housing, and element 14 is considered to comprise a hollow elongate support member, a majority of the length of element 14 is held within element 12 (see Yoon FIGS. 1, 15, 21, 22, 26, 30 and 37-38). Accordingly, claim 16 does not read on Yoon.

In addition, independent claim 16 calls for the slide member to have a slot, for the housing to have an opening aligned with the slot in the slide member, and for the axial dimension of the housing opening to be greater than the axial dimension of the slot in the slide member. The axial dimension of the slot in the slide member is greater than its transverse dimension. Opening 165 in Yoon is adapted to receive element 44; thus, opening 165 would appear to be cylindrical, and its axial dimension would not be greater than its transverse dimension. For this additional reason, claim 16 does not read on Yoon.

With respect to dependent claim 4 the characterization of Yoon is respectfully traversed. If element 26 of Yoon is considered to comprise the proximal opening, the slot 26 is sized or

shaped to be able to receive element 14 or element 16. If elements 14 and 16 of Yoon were assembled into a subassembly, this subassembly could not be inserted into element 12 through the slots 26. Accordingly, claim 4 does not read on Yoon and is patentable over Yoon.

With respect to dependent claim 6, the characterization of Yoon is respectfully traversed. If Yoon element 165 is considered to comprise an elongate slot and element 82 to comprise an opening[1], no portion of any lever is inserted through element 165 to reach element 82; instead, it appears that Yoon element 44 is inserted through 165, and element 44 is not a lever. Accordingly, claim 6 does not read on Yoon and is patentable over Yoon.

For all of the above reasons, claims 3-7, 9, 12, 14-17, 19 and 21 do not read on Yoon and are patentable over Yoon.

Cited References

US Published Application No. 2006/0161190, cited in the "Notice of References Cited," refers to provisional application, Ser. No. 60/725,234, filed on Oct. 11, 2005, provisional application, Ser. No. 60/665,069, filed on Mar. 24, 2005, and provisional application, Ser. No. 60/645,319, filed on Jan. 19, 2005. The present application was filed on June 26, 2003. Accordingly, US Published Application No. 2006/0161190 is not prior art to the present application.

CONCLUSION

In view of the above, it is believed that all of claims 3-7, 9, 12, 14-17, 19 and 21 are in condition for allowance. Reconsideration and reexamination of all of claims 3-7, 9, 12, 14-17, 19 and 21 is respectfully requested. Applicants respectfully requests that a timely Notice of Allowance be issued in this case.

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[1] Yoon describes element 82 as a groove and element 84 as a recess at col. 11, lines 11-15.

Respectfully submitted,

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